The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> DAVID PHILIP TONG

Appeal No. 2005-0212
Application 09/546,993

ON BRIEF

Before JERRY SMITH, BARRETT and RUGGIERO, <u>Administrative Patent Judges</u>.

JERRY SMITH, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 and 3-8, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for reducing colormap flashing on a display system having a frame buffer which provides a single hardware colormap.

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Representative claim 1 is reproduced as follows:

1. A method of reducing colormap flashing on a display system, the display system having a frame buffer which provides a single hardware colormap, the method comprising the steps of:

intercepting a request from an application program for an allocation of a private colormap; and

transparently simulating the allocation of the private colormap using a default colormap, wherein the default colormap is retained in the frame buffer during the simulating and the simulating includes allocating a secondary lookup table for storing information from the application program relating to the intercepted request; and

wherein said step of transparently simulating the allocation of a private colormap further comprises:

storing in the secondary lookup table information received from said application program relating to one or more requested colors privately allocated by said application program;

performing a closest match of said requested color to a color stored in said default colormap; and

returning said closest match to said application program.

The examiner relies on the following references:

Aschenbrenner et al.   5,406,310   Apr. 11, 1995
  (Aschenbrenner)
Young   5,703,627   Dec. 30, 1997

Claims 1, 3-5 and 7 stand rejected under 35 U.S.C.

§ 103(a). As evidence of obviousness the examiner offers Young

in view of Aschenbrenner. Claims 6 and 8 stand rejected under 35

U.S.C. § 102(b) as being anticipated by the disclosure of Young.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner fails to support the rejection of the claims on appeal. Accordingly, we reverse.

We consider first the rejection of claims 1, 3-5 and 7 under 35 U.S.C. § 103(a) based on Young and Aschenbrenner. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner

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is expected to make the factual determinations set forth in

Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in

the pertinent art would have been led to modify the prior art or

to combine prior art references to arrive at the claimed

invention. Such reason must stem from some teaching, suggestion

or implication in the prior art as a whole or knowledge generally

available to one having ordinary skill in the art. Uniroyal,

Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434,

1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil,

Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227

USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017

(1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572,

1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the

examiner are an essential part of complying with the burden of

presenting a prima facie case of obviousness. Note In re

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992). If that burden is met, the burden then shifts to the

applicant to overcome the prima facie case with argument and/or

evidence. Obviousness is then determined on the basis of the

evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make

in the brief have not been considered and are deemed to be waived

[see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how he finds the claimed

invention to be unpatentable over the teachings of Young and

Aschenbrenner [final rejection, pages 3-6, incorporated into

answer at page 3]. Specifically, the examiner essentially finds

that Young teaches the claimed invention except for the finding

of a closest match of a requested color in a default colormap.

The examiner asserts that Aschenbrenner teaches this feature.

The examiner finds that it would have been obvious to the artisan

to provide this teaching of Aschenbrenner to Young's system.

With respect to independent claim 3, appellant argues

that it is clear in Young that a private colormap is created for

a requesting application which is in direct contrast to claim 3

which recites that creation of a private colormap is not

performed. Appellant also argues that there is no teaching of

providing a reference to a cell in a default colormap because

Young relies on the private colormap and does not need to
reference the default colormap. With respect to independent
claim 1, appellant argues that Young provides no teaching of
simulating the allocation of a private colormap by allocating a
secondary lookup table because Young teaches the actual creation
of the private colormap. Appellant also argues that
Aschenbrenner does not make up for the shortcomings of Young
[brief, pages 8-11].

The examiner responds by showing a side-by-side
comparison of how Young teaches the invention of claims 3 and 1.
The examiner's comparison indicates that the examiner finds that
Young teaches the step of transparently simulating the allocation
of a private colormap using a default colormap in the manner
claimed [answer, pages 9-13].

Appellant responds that the examiner has failed to
understand the claimed invention because the claimed invention
does not use or allocate a private colormap whereas Young clearly
creates a private colormap [reply brief].

We will not sustain the examiner's rejection of
independent claims 1 and 3 or of claims 4, 5 and 7 which depend
therefrom. Independent claims 1 and 3 recite that the allocation
of a private colormap is transparently simulated. Although the

examiner finds that Young teaches this feature of the invention, as noted by appellant, Young teaches the actual creation of the private colormap. There is no need for a simulation of a private colormap in Young because the actual private colormap is created whenever an application requests it. Although the system disclosed by Young is designed to reduce colormap flashing on a display system, it achieves this result by copying information from the actual private colormap to the default colormap. The system of Young still switches between the default colormap and any private colormaps when different applications are active. Since the examiner's finding that Young teaches the claimed transparent simulation of a private colormap is erroneous, the examiner has failed to establish a prima facie case of obviousness.

We now consider the rejection of claims 6 and 8 as being anticipated by Young. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L.

Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554,
220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851
(1984). The examiner has indicated how he finds the claimed
invention to be fully met by the disclosure of Young [final
rejection, pages 7-10, incorporated into answer at page 3].

Appellant argues that Young does not anticipate claims 6
and 8 because Young does not teach simulating a private colormap
as opposed to actually creating one [brief, pages 5-8].

We will not sustain the examiner's rejection of claims 6
and 8 for the reasons argued by appellant in the briefs. As
noted above, we agree with appellant that Young fails to disclose
the transparent simulation of a private colormap because Young
teaches the actual creation of a private colormap. Since the
examiner's findings with respect to Young are erroneous, the
examiner has failed to establish a prima facie case of
anticipation.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1 and 3-8 is reversed.

<u>REVERSED</u>

Jerry Smith
JERRY SMITH   )
Administrative Patent Judge   )
)
)
Lee E. Barrett   )
LEE E. BARRETT   )   BOARD OF PATENT
Administrative Patent Judge   )   APPEALS AND
)   INTERFERENCES
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